

REMARKS / ARGUMENTS

The present application includes pending claims 1-31, all of which have been rejected. Claims 1, 11, and 21 have been amended. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-31 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Publication № 2001/0018771, issued to Walker et al. ("Walker"). The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the

resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Walker and Shoff Does Not Render Claims 1-31 Unpatentable

The Applicant now turns to the rejection of claims 1-31 as being unpatentable over Walker in view of Shoff. The Applicant notes that the proposed combination of Walker and Shoff forms the basis for all of the pending rejections.

A. Rejection of Independent Claims 1, 11, and 21

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Walker and Shoff does not disclose or suggest at least the limitation of “delivering, via a single communication path, the broadcast television program along with at least one synchronized functionality associated with the broadcast television program,” as recited by the Applicant in independent claim 1.

The Office Action states the following:

With respect to Claim 1, the claimed "delivering the broadcast television program along with at least one synchronized functionality associated with the broadcast television program, the broadcast television program and said at least one synchronized functionality for display on a television screen within a home" is met by Walker et al. that teach a system in which broadcast television programs are delivered to a television receiver 30 which displays the received content to a viewer 80, along with supplemental information synchronized with the events occurring within a particular video program, on an integrated display (Figs. 1 & 2; and paragraph [0020], [0030], [0040], [0042], [0055]).

See the Office Action at page 3. The Examiner relies for support on Figures 1-2 and ¶¶ 0020, 0030, 0040, 0042, and 0055 of Walker, and has equated Applicant's "synchronized functionality" with Walker's "supplemental information."

Walker, at ¶¶ 0020 and 0055, discloses that the video information and the supplemental information may be displayed on the same monitor (e.g., integrated display device 50 in FIG. 3). However, the Applicant points out that the **video information and the supplemental information are delivered separately**, which can be clearly seen in Walker's FIG. 1 (the video source 10 communicates the video information and the supplemental information is delivered via the computer data communication network 20).

Walker, at ¶ 0030, discloses that the supplemental information is received via an Internet web site (i.e., **separately** from the video information from the video source 10), and it is displayed at a computer monitor, which is **separate** from the TV receiver used for displaying the video information.

Walker, at ¶ 0040, discloses that the supplemental information is synchronized to the video program.

Walker, at ¶¶ 0041-0042, discloses that a television receiver 30 may receive a video program from a video source 10 and display the received video program to the viewer 80. See Walker at FIG. 1 and ¶¶ 0041-0042. Walker also discloses that the viewer 80 may access supplemental information **separately** via the web server 70. The supplemental information is then sent (**separately** from the video broadcast by the video source 10) to the viewer 80 in the form of a web page for display on the personal computer 40. In this regard, **Walker does not disclose or suggest that the broadcast television program is delivered, via a single communication path, along with at least one synchronized functionality associated with the broadcast television program**, as recited in Applicant's claim 1. With regard to the video program sent from the video source 10, Walker discloses that program identification information 30 and synchronization information 32 may also be communicated to the viewer 80. The viewer 80 then provides the received information 30 and 32 to the web server in order to obtain the supplemental information. In this regard, **the video program received from the video source 10, including the identification information 30 and the synchronization information 32, does not include any user-selectable options**, as recited by the Applicant in claim 1.

Furthermore, as already illustrated by the above argument, Walker's broadcast television program is delivered separately from, and not from the same

location as, the “synchronized functionality.” In other words, Walker’s “at least one synchronized functionality” does not originate from the same location as Walker’s “broadcast television program” and it is not delivered via a single communication path.

The Applicant respectfully draws the attention of the Examiner to the prohibition as set forth in M.P.E.P. § 2143.01 which states that “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” See M.P.E.P. § 2143.01. Walker specifically discloses that the video program and the supplemental information are received via separate communication paths, which are of different types (TV broadcast network and Internet communication network). In this regard, the video program and the supplemental information cannot be received via a single communication path. Shoff does not (and cannot) overcome the deficiencies of Walker.

Therefore, the Applicant maintains that the combination of Walker and Shoff does not disclose or suggest at least the limitation of “delivering, via a single communication path, the broadcast television program along with at least one synchronized functionality associated with the broadcast television program,” as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Walker and Shoff does not disclose or suggest at least the limitation of “the broadcast television program and said at least one synchronized functionality being of the same format and for display on a television screen within a home,” as recited by the Applicant in independent claim 1. As already explained above and as illustrated in FIG. 1 of Walker, the video programs received from the source 10 are displayed at a TV receiver 30. However, the supplemental audio/video information received from the network 20 is displayed at a personal computer 40. Not only are the video program and the supplemental information of different formats, but they are also not displayed at the same TV screen in the home. Shoff does not overcome these deficiencies of Walker (the Applicant notes that Shoff’s supplemental information is in hypertext format, which is obviously different from the format of the on-demand video data received from server 42).

Therefore, the Applicant maintains that the combination of Walker and Shoff does not disclose or suggest at least the limitation of “the broadcast television program and said at least one synchronized functionality being of the same format and for display on a television screen within a home,” as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Walker and Shoff does not disclose or suggest at least the limitation of “wherein said at least one synchronized

functionality originates from the same broadcast provider location as the broadcast television program,” as recited by the Applicant in independent claim 1.

The Office Action concedes Walker does not disclose the above limitation and then states the following:

In a similar field of invention, Shoff et al. teach a method of providing an interactive entertainment system that enables the presentation of supplemental interactive content along side traditional broadcast video programming. Shoff further teaches that supplemental content is supplied as part of the same program signal over the broadcast network (with reference to Interactive Entertainment System 20 of Fig. 2 showing Video Programs 40 and Supplemental Content 54 both originating from the Centralized Headend 22; as described in Col. 4 Lines 14-61 with further reference to Col. 3 Lines 4-13, Col. 5 Lines 12-60, and Col. 10 Lines 18-33). In addition, Shoff discloses that the interactive data can contain various control options to the viewer in order to invite interactive involvement with the program (as described in Col. 10 Line 59- Col. 11 Line 11; with further reference to Fig. 8b).

See the Office Action at page 4. Referring to FIG. 2 of Shoff, the headend 22 provides on-demand video streaming of video programs stored in the database 40 within the continuous media server 42. The headend 22 can also communicate broadcast video signals to its subscribers. However, the broadcast video signals are re-transmitted since they originate from a satellite feed or a cable system feed, i.e., remotely from the headend 22. In this regard, the broadcast video signals and the supplemental content do not originate from the same broadcast provider location.

Even if we assume that Shoff's broadcast video signals and supplemental content originate from the same location, Shoff is still deficient since, as already

explained above, it does not disclose that the broadcast television program and the supplemental information are of the same format.

Therefore, the Applicant maintains that the combination of Walker and Shoff does not disclose or suggest at least the limitation of "wherein said at least one synchronized functionality originates from the same broadcast provider location as the broadcast television program," as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not unpatentable over Walker in view of Shoff and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-10, 12-20, and 22-31

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Shoff has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20, and 22-31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-31.

In general, the Office Action makes various statements regarding claims 1-31 and the cited reference that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 06-NOV-2008

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